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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/734,851   | 12/11/2003  | Ned Hoffman          | 8514-114 (ST-A22-DIV) | 1943             |
| 20575  | 7590        | 03/15/2006           | EXAMINER              |                  |
| MARGER JOHNSON & MCCOLLOM, P.C.<br>210 SW MORRISON STREET, SUITE 400<br>PORTLAND, OR 97204 |             |                      | FISCHETTI, JOSEPH A   |                  |
|  |             |                      | ART UNIT              | PAPER NUMBER     |
|  |             |                      | 3627                  |                  |

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/734,851

Applicant(s)

HOFFMAN, NED

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 2,9-15,17,18,20,21,23 and 27-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,16,19,22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Election/Restrictions***

Claims 2, 9-15,17,18,20,21,23,27-44<sup>are</sup> withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species/inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/15/05. Applicant argues the species election is improper because "claims are never species" However, it should be understood that typically in non-abstract subject matter applications, it is easy to refer to figures to identify species, e.g. embodiments. However, since the various embodiments are covered through abstract descriptions and don' t always have a drawing accompanying same, the examiner uses the claim recitations to provide a description which should otherwise be provided by an illustration. According, the election is deemed proper and is made FINAL.

***Double Patenting***

Claims 1,3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6269348, 5870723 and 5838812. Although the conflicting claims are not identical, they are not patentably distinct from each other because at least claim 1 of the identified patents can be read on claims 1 and 3 of this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5,19, 22, 24, 25, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5,19,22,24,25,26 are improperly presented Markush recitations and hence have plural meanings. In order to be proper Markush group claim it is necessary that the applicant invoke the words "consisting of" See, ex parte Dotter, 12 USPQ 382. In order to be used correctly, a Markush group claim must use the phrase "selected from the group consisting of ...". Barring that, the claims are indefinite because they otherwise recite plural groups of elements which must be read into the claim collectively making it indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-8,16,19, 22, 24, 25, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Merjanian 471.

Merjanian disclose with respect to the authentication system for use with a computer terminal col. 9 or the example of the welfare recipient of col.11 lines 1-21, which do not involve a smart card and thus, is "tokenless", and transmits through an interface 40 and thus meets the limitations of: a. a scrip supporter registration step, wherein a scrip supporter registers with an electronic identifier at least one registration biometric sample (see col. 9 lines 31-33, fingerprint data must match predetermined parameters which parameters inherently require the step of registration) ; b. an electronic scrip transaction proposal step comprising an electronic scrip donor account data(account is read as the user account of the computer) at least one transmittal step, wherein a scrip supporter bid biometric sample is obtained from the scrip supporter's person and is electronically transmitted to the electronic identifier (col. 9 lines 41,42 fingerprint data is conveyed via interface 40 to data base 24) ; and d. a scrip supporter identification step, wherein the electronic identifier compares the bid biometric sample with at least one registration biometric sample for producing either a successful or failed identification of the scrip supporter Col. 9, line 33 a match is sought against the two data for the fingerprints) wherein upon successful identification of the scrip supporter, a scrip transaction is biometrically authorized, (access to the terminal is thus allowed). The phrase "without the scrip supporter presenting any smartcards or magnetic swipe cards" is met by the example of computer login or the example of the welfare recipient of col.11

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lines 1-21, but notwithstanding this, the language remains a negative limitation and is not given weight.

Regarding the new limitations drawn to electronic script, the use of food stamps inherently is the use of an electronic script. As evidence of this, the home page of VADEPTSS is attached defining food stamps as "electronic benefits". With that established, an electronic food stamp is read merely a another form of electronic coupon. Applicant describes "script" as: e.g., actual tender in the form of paper coupons. Col 10 of Merjanian discloses use in controlling food stamp distribution.

Re claims 3, 4, 8: the Medicaid office is read as a clearing house for medical claims/payments. The disclosed matching program using minutiae of the fingerprint characteristics is read as the rule module.

Re claim 5 the PIN is deemed to inherently be an identification code.

RE claim 6: the donator scout is the state and the beneficiary account is the food stamp user.

Re claim 7: interface 40 transmits to an external system.

Re claims 16/24/28: the Medicaid account is read as the donor account and is the scrip service merchant which gets presented the results of the transaction.

Re claim 19/25: food stamp purchase inherently logs date and time information and dollar value.

Re claim 22: Merjanian teaches fingerprint recognition.

Re claim 26: electronic coup[on have the stored value of the face value.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-8,16,19, 22, 24, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merjanian 471 in view Laor.

Merjanian discloses the invention substantially as claimed as set forth above. However, insofar as the recitation of electronic coupons is definite, Merjanian discloses food stamp usage which is a form of la coupon, but not explicitly disclosed as electronic. But Laor does disclose electronic coupons as a form a script. It would be obvious to modify Merjanian to include the electronic feature of the coupon in Laor the motivation would be to reduce fraud by electronically tying the script to the data of the biometric.

Claims 1,2-8,16,19, 22, 24, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merjanian in view of Laor and further in view of Pu et al. or Kuhns et al.

Merjanian discloses the invention substantially as claimed as set forth above. However, applicant has argued that Merjanian fails to disclose an "identification" system. However, Pu et al., in col. 9 line 43, col. 11, line 40, and Kuhns et al, col. 1 (criminal history identification) all make clear use of the word "identification" to describe

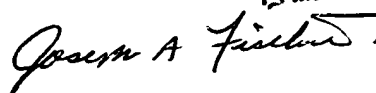
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its system. It would be obvious to modify the system in Merjanian to include the identification systems of Pu et al., or Kuhns et al. with that of Merjanian because the motivation for this would be to offer an increased level of reliability by identification rather than verification.

Both Pu et al and Kuhns et al. disclose identification and hence answer the limitations of the claims.

Insofar as the recitation of electronic coupons is definite, Merjanian discloses food stamp usage which is a form of la coupon, but not explicitly disclosed as electronic. But Laor does disclose electronic coupons as a form a script. It would be obvious to modify Merjanian to include the electronic feature of the coupon in Laor the motivatio0n would be to reduce fraud by electronically tying the script to the data of the biometric.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number 571 272 6780.



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JOSEPH A. FISCHETTI  
PRIMARY EXAMINER